

ODELL and others v. STOUT and others.¹

(Circuit Court, S. D. Ohio, W. D. October, 1884.)

1. PATENTS—REISSUES—ENLARGING CLAIMS—COMBINATION—PARTS.

The introduction into reissued letters patent of claims for the patentable parts of the combination claimed in the original letters, does not invalidate the reissued letters, if the patentee was the first inventor of the patentable parts claimed, although the original patent was for the combination alone, so described and claimed that the parts were not to be used separately, but together and simultaneously.

2. SAME—LIMITS OF RULE.

A patentee may, under proper circumstances, by reissue, enlarge his claims so as to make them extend to the limits of his invention, but he is bound by those limits.

3. SAME—WHEN CLAIMS MAY BE ENLARGED.

Miller v. Brass Co. 104 U. S. 350, *James v. Campbell*, Id. 371, and later cases decided by the supreme court, distinctly recognize that the claims of an original patent may be enlarged by reissue to include the entire invention and its distinct patentable features; provided—*First*, that there be no unreasonable delay in applying for the reissue; and, *second*, that between the date of the original patent and that of the application for the reissue, rights which would be recognized in favor of others have not intervened.

4. SAME—WITHIN WHAT TIME APPLICATION TO BE MADE—WHAT IS A REASONABLE TIME.

There is no rule fixing the precise time within which application for a reissue must be made. What is a reasonable time, is a question, when a reissue is attacked, to be decided by the court upon the case presented. The rule is equitable, and therefore flexible, and to be applied according to equity.

5. SAME—DATE OF INVENTION—DRAWINGS.

Drawings made by an inventor, prior to his application for a patent, carry date of invention back, if reasonable diligence in applying for a patent is shown. But they will not supersede a patent granted to another in the mean time for the same invention.

6. SAME—REISSUES—EFFECT UPON OTHER CLAIMS OF INVALIDITY OF ONE.

The invalidity of one of the claims of a reissued patent does not invalidate the entire reissue, provided the invalid claim was made in good faith. Where it appears that claims in a reissued patent were made to broaden the invention, and thereby to cover intermediate inventions or improvements, the fraud may so vitiate all the claims in the reissued patent that all will be held to be void. But one claim in a reissue may be void without necessarily invalidating the other claims.

7. PATENT SUITS—INFRINGEMENT—ABANDONMENT—INJUNCTION.

If a defendant has, before suit brought, abandoned the manufacture and sale of an infringing machine, and the court is satisfied that the abandonment was in good faith, and final, an injunction ought not to be granted. But if the defendant, after such abandonment, has engaged in the manufacture and sale of another machine, which is also an infringing machine, and suit is brought for both infringements, the court will retain the whole cause under its control, and make the injunction and order to account to apply to the manufacture and sale of both.

8. PATENTS—ODELL PATENT FOR ROLLER-MILLS.

The first claim of reissued letters patent No. 10,139, granted to complainant Odell, June 22, 1882, for an improvement in roller-mills for crushing or grinding grain, middlings, and other material, held to be invalid; the second and fourth claims sustained. Complainants required to file a disclaimer of the first claim, before decree, and the decree for an injunction and account to be without costs.

¹Reported by J. C. Harper, Esq., of the Cincinnati bar.

In Equity.

Wood & Boyd, for complainants.

Stem & Peck and *L. Hill*, for defendants.

Before MATTHEWS, Justice, and SAGE, J.

SAGE, J. Letters patent No. 250,934, for an improvement in roller-mills for crushing or grinding grain, middlings, and other material, were issued December 13, 1881, and reissued (No. 10,139) June 22, 1882, to the complainant Odell, who, (with the Stillwell & Bierce Manufacturing Company, his licensees,) sues for infringement. The object of the invention is stated in the specification to be to adjust the outer crushing or grinding rolls to or from the inner ones, and simultaneously to open or close the spouts or channels which control the discharge of grain from the hopper to the feed rolls.

The first claim in the reissued letters patent is as follows:

"In a roller-mill, the combination of the hopper-gate mechanism on both sides of the machine with a through shaft, lever mechanism connecting the parts to operate the gates simultaneously, and a single hand-lever, substantially as and for the purpose described."

The drawings show a double mill. The hopper is divided by a partition. Under each side of the hopper is a set of rolls to which the grain is delivered by means of a feed-spout. Gates or slides, moving vertically inside the hopper, open and close the aperture leading to the feed-spouts. These gates are connected by rods with a through shaft, J, located above the center of the space between the two sets of rolls, and parallel with them, and connected also with a single hand-lever, K. By the movement of this lever to or from the operator the gates are closed and opened.

Claim 2 is as follows:

"In a roller-mill, the combination with the adjustable rolls and journals of transverse shaft, *h*, through shaft, J, link mechanism connecting said shafts, and a single hand-lever, K, connected with the through shaft, for simultaneously adjusting both sets of rolls by a single-lever movement, substantially as described."

The outer grinding rolls are journaled in vibrating arms, so connected on each side of the mill, by transverse horizontal shafts, with the hand-lever, K, that by the movement of that lever the rolls are thrown apart, (or spread,) or brought into contact, (or set,) simultaneously with the opening or closing of the hopper gates. The transverse shafts are provided with coiled springs, which form a yielding bearing for the outer rolls, so that they may give from their grinding position and permit the passage of any hard foreign substance which would otherwise injure the rolls.

Claim 3 is not involved.

Claim 4 is as follows:

"In a roller-mill the combination, with the adjustable crushing rolls and the gates or slides which control the passage of grain from the hopper, of a single through shaft, J, a single hand-lever, K, and mechanism connecting the crushing rolls and the gates or slides with the through shaft and hand-